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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,130	01/16/2004	Terrence John Morris	FORRB 67045	7201
24201	7590	10/31/2005		
FULWIDER PATTON LEE & UTECHT, LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE TENTH FLOOR LOS ANGELES, CA 90045			EXAMINER BASICHAS, ALFRED	
			ART UNIT	PAPER NUMBER
			3749	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/760,130

Applicant(s)

MORRIS, TERRENCE JOHN

Examiner

Alfred Basichas

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/10, 10/18/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. The election requirement mailed August 16, 2005, is hereby withdrawn. After further consideration, it has become clear that the various embodiments shown in the drawings are not patentably distinct. Accordingly, applicant's arguments of the election received September 16, 2005, are moot.

### ***Drawings***

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishida (5,387,399), Eltron (DE4223513), or Bosch (DE29504255), which show all of the claimed limitations. Nishida/Eltron/Bosch show a burner with a burner head including a fuel inlet and a plurality of firing portion having a plurality of spaced apart elongated elements M/7,8,9/54 with elongated fuel flow passages (see at least figs. 2a,2b)/4/58.

5. Claims 1, 2, 5, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Alexander (WO9105973), which shows all of the claimed limitations. Alexander shows a burner with a burner head including a fuel inlet and a plurality of firing portion having a plurality of spaced apart elongated elements 7 with elongated fuel flow passages, wherein the elements are made of ceramic wire 2 and is spirally wound into a generally tubular form (see at least fig. 2).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 3, 4, and 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander (WO9105973) in view of Nishida (5,387,399). Alexander discloses substantially all of the claimed limitations, but does not specifically recite the claimed wire wedge shape or the various element orientations.

- a. Nishida teaches wedge shaped elongated elements (see at least figs. 9a-c) including various element orientations (see at least figs. 2a,3a,7,8,10,11).

Nishida teaches that the variations have distinct characteristics and uses depending on the needs of the device (see at least col. 7, line 60, through col. 8, line 42). Accordingly, it would have been obvious at the time of the invention to incorporate the claimed wedge shape and element orientations as made obvious by Nishida into the invention disclosed by Alexander, so as to provide for the uses and need of the device.

- b. It should further be noted that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or

workable characteristics involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Swain*, 156.

c. In addition, as regards Nishida's elements not being made of wire, while Nishida may be silent as to how the apparatus is manufactured, the prior art apparatus appears to be the same as claimed. This product-by-process limitation would not be expected to impart distinctive structural characteristics to the apparatus. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize any process including, that which is recited in the claims to have produced the elongated elements. *Note: Applicant may overcome this rejection by providing evidence that the claimed product-by-process limitation imparts a distinctive structural characteristic to the claimed invention, but a statement or argument by Applicant will not be deemed factual evidence. Of course, even if evidence were provided to overcome anticipation, one would still need to assess whether it would have been a prima facie obvious method.*

### ***Prior Art***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These references disclose burners and burner heads with many, if not all, of the claimed components. Nevertheless, in order to avoid overburdening the applicant with redundant rejections, these references were not applied.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Basichas whose telephone number is 571 272 4871. The examiner can normally be reached on Monday through Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571 272 4828. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center telephone number is 571 272 3700.

October 24, 2005

  
Alfred Basichas  
Primary Examiner